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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,522	02/19/2004	Joseph G. Swan		4715

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EXAMINER

TRINH, TAN H

ART UNIT	PAPER NUMBER
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2618

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/782,522

Applicant(s)

SWAN, JOSEPH G.

Examiner

TAN TRINH

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 24-36 is/are rejected.
- 7) ☒ Claim(s) 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 and 29 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 7-15-2004, 1-24-2005 and 01-03-2006, the information disclosure statement has been considered by the examiner.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 18-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/289,896. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims 18-36 of the instant application are encompassed by the limitations of the claims 1-20 of the copending Application.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-20, 24-30 and 36 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Daswani (U.S. Pub. No. 2003/0061307).

Regarding claim 18, Brown teaches a system for sharing contact information (see page 2, paragraph [0020]), the system comprising:

(a) central hub that maintains and distributes contact information (see fig. 1-2, page 2-3 and paragraphs [0022 and 0029]);

(b) plural terminals that electronically communicate with the central hub (see page 2-3 paragraphs [0021-0022 and 0027 with 0029]);

(c) plural contacts, each the contact having an associated contact record that is maintained by the central hub (see page 3, paragraphs [0029 with 0032]),

wherein upon receipt of a contact-record request from one of the plural terminals, the central hub automatically transmits a matching contact record to the requesting terminal (see page 5, paragraphs [0041-0042]),

and wherein each of the plural terminals has an ability to retrieve any of the contact records maintained by the central hub for the plural contacts (see page 5-6, paragraphs [0042, 0045-0046]). But Brown does not mention the central hub implements procedures to preclude mass downloading of contact information.

However, Daswani teaches the network implements procedures to preclude mass downloading (limits download) of contact information (see Daswani pages 1-2, paragraph [0011]). In this case, since the preclude mass downloading, can be limited download data sizes, speed of connection, and how many time of downloading and the type of data content.

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Brown with Daswani, in order to provide user with easily made available for transmission to and presentation by variety of known communication devices having capacity to connect to network (see suggested by Daswani on page 2, paragraph [0012]).

Regarding claim 19, Brown teaches the central hub permits the contacts to limit fields in their corresponding contact records which may be searched in response to contact-record requests from the plural terminals (see Brown page 3, paragraph [0032]). In this case, the data fields in which in which individual terminal can be enter information and pull-down menus that comprise various information the user can select.

Regarding claim 20, Daswani teaches the procedures to preclude mass downloading of contact information include limiting a number of contact records that may be downloaded by each end user (see Daswani pages 1-2, paragraph [0011]). In this case, since the preclude mass downloading, can be limited download data sizes, speed of connection, and how many time of downloading and the type of data content.

Regarding claim 24, Daswani teaches the procedures to preclude mass downloading of contact information include correlating reports of junk email from the contacts with broad searches conducted by registered end users (see Daswani pages 1-2, paragraph [0011]). In this case, since the preclude mass downloading, can be limited download data sizes, speed of connection, and how many time of downloading and the type of data content (junk mail).

Regarding claim 25, Brown teaches the central hub requires the contact-record request to include identity-confirming information, in addition to a unique identification code that uniquely identifies the matching contact record, in order to retrieve the matching contact record (see page 4-5, paragraphs [0035-0037 and 0041-0042]). In this case, the matching contact record can be the user name and password (see paragraphs 0037).

Regarding claim 26, Brown teaches the identity-confirming information comprises additional contact information for a contact corresponding to the contact-record request (see page 4-5, paragraphs [0035-0037 and 0041-0043]). In this case, the matching contact record can be the user name and password (see paragraphs 0037) and additional contact information can be graduating class in high school, employees (see paragraphs 0043).

Regarding claim 27, Brown teaches the central hub cuts off an end user for having too many invalid contact-record requests (see page 4-5, paragraphs [0037-0038]). In this case, since the denial of the access the for user with more control over with whom his or her information is share, is read on the central cuts off an end user for having too many invalid contact-record requests.

Regarding claim 28, Brown teaches the identity-confirming information verifies that the contact-record request corresponds to a valid contact record (see page 1, paragraph [0010]) and (see page 4-5, paragraphs [0035-0037 and 0041-0043]).

Regarding claim 29, Brown teaches each of the contacts is provided with an ability to make the associated contact record for the contact available through general search queries (see page 3, paragraphs [0032-0033]). In this case, since the program is running, for search update the contact and stored that is the general search queries.

Regarding claim 30, Brown teaches the matching contact record includes plural different contact information fields and is in a format that permits unambiguous identification of the plural different contact information fields upon application of pre-specified mechanical rules (see Page 4-5, paragraphs [0035-0036 and 0041-0042]).

Regarding claim 36, Brown teach the contact-record request is initiated by, and the matching contact record is received by, an electronic address book program running on the requesting terminal (see page 3, paragraph [0029] and page 5 and paragraphs [0039-0042]).

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Daswani (U.S. Pub. No. 2003/0061307) further in view of Sagi (U.S. Patent No. 6,865,384).

Regarding claim 31, Brown or Daswani fails to teach a format in which the matching contact record is transmitted from the central hub to the requesting terminal is selected by the central hub based on a preference expressed by the user.

However, Sagi teaches a format in which the matching contact record is transmitted from the central hub to the requesting terminal is selected by the central hub based on a preference expressed by the user (see Sagi col. 1-lines 58- col. 2, line 13 and col. 2, lines 58-col. 3, line 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above of the combination of the teaching of Brown and Daswani with Sagi, in order to provide the compatibility for users who can not accept the default of the retrieved documents (see suggested by Sagi on col. 3, lines 1-13).

7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Daswani (U.S. Pub. No. 2003/0061307) further in view of Osborn (U.S. Patent No. 6,760,728).

Regarding claim 32, Brown or Daswani fails to teach wherein in response to the contact-record request the central hub transmits plural matching contact records to the requesting terminal.

However, Osborn teaches in response to the contact-record request the central hub transmits plural matching contact records to the requesting (see col. 2, lines 39-59). In this case, Osborn teaches the exporting directory and calendar information to and from personal information management applications comprising translating information into format native to the corresponding target applications.



Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above of the combination of the teaching of Brown and Daswani with Osborn, in order to provide the compatibility for users who can not accept the default of the retrieved documents (contacts) (see suggested by Osborn on col. 2, lines 39-58).

8. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Daswani (U.S. Pub. No. 2003/0061307) further in view of Harari (U.S. Pub. No. 2002/0016857).

Regarding claim 33, Brown or Daswani fails to teach the central hub records identities end users that have stored a particular contact record and notifies at least some of said end users when the particular contact record subsequently is modified.

However, Harari teaches the central hub records identities end users that have stored a particular contact record (see page 4, paragraph [0039]) and notifies at least some of the end users when the particular contact record subsequently is modified (see page 4, paragraphs [0038-0040]). In this case, since Harari teaches address contact information retrieval, update, change and email contact list, that is read on the notify and modified of the claim invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above of the combination of the teaching of Brown and Daswani with Harari, in order to provide users up to date of the contact list (see suggested by Harari on page 2, paragraphs [0038-0039]).

Regarding claim 34, Brown or Daswani fails to teach upon receipt of the matching contact record by the requesting terminal, the matching contact record automatically is displayed in a manner so as to allow a user of the requesting terminal to edit individual information fields within the matching contact record prior to causing the matching contact record to be stored into an electronic address book of the requesting terminal.

However, Harari teaches upon receipt of the matching contact record by the requesting terminal, the matching contact record automatically is displayed in a manner so as to allow a user of the requesting terminal to edit individual information fields within the matching contact record prior to causing the matching contact record to be stored into an electronic address book of the requesting terminal (see page 4, paragraphs [0035-0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above of the combination of the teaching of Brown and Daswani with Harari, in order to provide users store information and increases application usability.

Regarding claim 35, Brown or Daswani fails to teach upon receipt of the matching contact record by the requesting terminal, the matching contact record automatically is stored into an electronic address book of the requesting terminal.

However, Harari teaches upon receipt of the matching contact record by the requesting terminal, the matching contact record automatically is stored into an electronic address book of the requesting terminal (see pages 4-5 paragraphs [0026-0027] and [0038-0039]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above of the combination of the teaching of Brown and Daswani

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with Harari, in order to provide users save with up to date of the contact list (see suggested by Harari on page 2, paragraphs [0038-0039]).

***Allowable Subject Matter***

9. Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 21, Brown and Daswani teaches a system for sharing contact information, However, Brown and Daswani fails to teaches the procedures to preclude mass downloading of contact information include limiting a number of matching contact records provided to each requesting end user as specified in dependent claim 21.

Regarding claims 22 and 23 , Brown and Daswani teaches a system for sharing contact information, However, Brown and Daswani fails to teaches the procedures to preclude mass downloading of contact information include monitoring and restricting repeated broad searches conducted by a same end user or across multiple end users as specified in dependent claims 22 and 23.

***Conclusion***

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(571) 273-8300, (for Technology Center 2600 only)**

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*Hand-delivered responses should be brought to the Customer Service Window (now located at the **Randolph Building, 401 Dulany Street, Alexandria, VA 22314**).*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Anderson, Matthew D., can be reached at (571) 272-4177.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is (703) 306-0377.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh  
Division 2618  
April 24, 2007

**PATENT EXAMINER**  
**TRINH, TAN**

